

**AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116**

Serial Number: 09/801,221

Filing Date: 3/7/2001

Title: Human Cord Blood as a Source of Neural Tissue for Repair of the Brain and Spinal Cord**Page 3**

Dkt: USF-001US

**REMARKS/ARGUMENTS**

Applicants herein respond to the Office Action of August 15, 2006.

Claim 90 is amended, claim 125 has been added, and claims 1-89 and 91-124 have been canceled; as a result, claims 90 and 125 are now pending in this application.

Applicants thank the Examiner for the courtesy of an interview. The Office Action and response were long and involved and cited several references. The Interview was particularly beneficial in narrowing the topics of contention and indeed finding ways to answer all the objections of the Examiner. It became clear that the Examiner was rejecting the independent claim for including embodiments whose successful function was not detailed in the specification.

**35 U.S.C. 112, 1st Paragraph, Rejection of the Claims**

Claims 90, 94, 95 and 124 were rejected under 35 USC §112, first paragraph, as containing new matter including the phrase "growing the mononuclear cells in a serum-free medium consisting of EGF, bFGF, pokeweed mitogen, Ara-C or a combination thereof..." etc. Applicants have cancelled claim 124 with that language and have entered new claim 125, which lacks "consisting of" and "pokeweed mitogen and Ara-C" to which the Office Action objected.

Claims 90 and 124 were rejected for the inclusion of subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. However, the Examiner provided some claim language which would be patentable thereunder. Applicants have incorporated this language into new claim 125. Applicants believe that the last term in the proposed language (a cell of interest) could be improved by "cells bearing neural progenitor markers," which reflects the language of page 40, line 4 ("gives rise to cells bearing neural progenitor markers"). Claim 125 does not recite the comparative information from Table I or Table II, so that aspect of the rejection also may be withdrawn.

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Page 4

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The Office Action again cited Jackowski (1995) but appeared to indicate that Jackowski would not be applied if the scope of the independent claim were narrowed to RA+NGF. Since the scope has been so narrowed, it is believed that this reference is no longer being applied.

The Office Action stated that Grados-Munro et al. (2003) is post-filing art, which Applicants understand to mean that it has been withdrawn from the rejection. The same comment was made with regard to Filbin (2003), and Applicants draw the same conclusion.

The Mehler and Kessler reference too was not applied to claims limited to RA+NGF, so it is believed that this reference is not being applied against the new claims.

The Office Action reiterated the rejection of claims 94 and 95 and cited the Bonnet, 2002, reference. Since those claims have been cancelled, this ground for rejection is now moot and may be withdrawn. It is believed that grounds for rejection under 35 USC 112, 1<sup>st</sup> paragraph, may be withdrawn.

*35 U.S.C. 112, 2d Paragraph, Rejection of the Claims*

Claims 90, 94 and 95 and 124 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 94 and 95 have been cancelled, so their rejection is moot. Claim 90 now depends from claim 125, which recites retinoic acid, so it is believed that this rejection also is moot.

Claims 90, 94 and 95 and 124 were considered indefinite because it was unclear what would be considered the reference state for increases and decreases in gene expression. This was also discussed in the telephone call and has not yet been resolved. Therefore, Applicants have cancelled claim 124 with that claim language and have replaced it with claim 125 which features the non-comparative language "cells bearing neural progenitor markers." Therefore, Applicants believe this ground for rejection may be withdrawn.

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Page 5

Dkt: USP-001US

Conclusion

Applicants respectfully submit that claims 90 and 125 are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned to facilitate prosecution of this application.

Respectfully submitted,

Date August 21, 2006  
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